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OFFICE OF PETITIONS

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In re Application of :
Nezu et al. :
Application No. 10/762,154 : ON APPLICATION FOR
Filed: January 21, 2004 : PATENT TERM ADJUSTMENT
Atty Docket No. 14875-057002/ :
C2-906DP1P :

This decision is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(b)," filed March 3, 2011. Applicants request the PTA determination for the above-identified application be corrected to nine hundred twenty-five (925) days.

The request for reconsideration of patent term adjustment is **DISMISSED** with respect to making any changes to the patent term adjustment of eight hundred ninety-five (895) days.

On December 3, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 895 days. On March 3, 2011, applicants submitted the instant correspondence in which applicants request the patent term adjustment be reduced for the delay associated with filing a response to the September 27, 2007 final Office action.

37 CFR 1.704(b) provides that:

With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or

action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

A final Office action was mailed on September 27, 2007. On February 25, 2008, applicants filed an amendment after final. On April 11, 2008 and August 1, 2008, the Office mailed Advisory Actions that state the February 25, 2008 amendment after final failed to place the application in *prima facie* condition for allowance.

On March 26, 2008 applicants filed a Notice of Appeal.

Applicants argue that because the Board of Patent Appeals and Interferences mailed a decision in favor of applicants on April 13, 2010, that the February 25, 2008 amendment was a complete and timely response to the final Office action of September 27, 2007.

Applicants' three month clock to respond to a final Office action did not stop until applicants filed a response in compliance with 1.113(c). Per the April 11, 2008 and August 1, 2008 Advisory Actions, the February 25, 2008 amendment after final failed to place the application in *prima facie* condition for allowance. The fact that the Board reversed the examiner does not mean that the response to the final Office action was a complete response to the final rejection. It is noted that applicants filed an appeal brief containing arguments subsequent to the filing of the February 25, 2008 amendment after final and March 26, 2008 Notice of Appeal. The Notice of Appeal is the 1.704(b) response that stops the clock and is used for purposes of calculating applicant delay.

Accordingly, a period of reduction of 90 days was properly entered for the period beginning on December 28, 2007, the day after the date that is three months after the date of mailing of

the final Office action, and ending on March 26, 2008, the date a Notice of Appeal was filed. No changes will be made.

In view thereof, the correct patent term adjustment at the time of mailing of the Notice of Allowance on December 3, 2010 remains **eight hundred ninety-five (895) days** (1140 days Office delay minus 245 days Applicant delay).


The Office acknowledges receipt of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b). No additional fee is required.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3230.


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Office of Petitions